

CD



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,882	08/18/2003	Karin Bergstrom	PST6148US1/2159	3321

7590 06/17/2004

RALPH J. MANCINI
 AKZO NOBEL INC.
 7 LIVINGSTONE AVENUE
 DOBBS FERRY, NY 10522-3408

EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
----------	--------------

1621

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,882

Applicant(s)

BERGSTROM ET AL.

Examiner

Rosalynd Keys

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5,9-12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-15 are pending.
Claims 1-4, 6-8, 13 and 14 are rejected.
Claims 5, 9-12 and 15 are withdrawn from consideration.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-4, 6 and 7 in the reply filed May 14, 2004 is acknowledged.

The traversal is on the grounds that the present Examiner was also the Examiner in the aforementioned parent application to the present case. In that parent application, claims 1-4, 6 and 7 (comprising present Group I in the restriction), claim 8 (part of Group III of the present restriction) and claim 13 (comprises Group VI of the present restriction) were examined by the present Examiner and prosecuted all the way to Appeal. When the Appeal was unsuccessful, applicants filed the present case, along with additional comparative data. Accordingly, while applicant submits that it would not constitute a serious burden to examine all of the claimed inventions in a single application, at a minimum, it clearly should not be a serious burden to examine Groups I, III and VI comprising claims 1-4, 6, 7, 8, 13, 14, and 15 in a single application as this was already done in the parent case.

This argument is found persuasive for claims 8, 13 and 14. Further, since the preambles to these claims merely disclose an intended use, which is generally not accorded any patentable weight, these claims will be examined along with Group I,

Art Unit: 1621

claims 1-4, 6 and 7. However, this argument is not found persuasive for claim 15 because it is directed to a method of use. Restriction is proper between the product and method of using if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product, such as the composition containing a hexyl glycoside, as disclosed by Johansson et al. in US 6,641,442 B1.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 5, 9-12 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 14, 2004.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Sweden on December 19, 1997. It is noted, however, that applicant

Art Unit: 1621

has not filed a certified copy of the foreign application as required by 35

U.S.C. 119(b). ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

Art Unit: 1621

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-4, 6-8, 13 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Askew et al. (US 4,450,087) or Elliott et al. (US 3,903,006).

Askew et al. disclose an ortho ester having the formula (I). See column 2, lines 12-29.

Askew et al. also disclose ortho esters which are adjacent homologues, i.e., structurally similar, to the ortho ester having the formula (I) (see Table 3). The claimed ortho ester having formula (I) would have been obvious to the skilled artisan because the close structural similarity of the ortho ester of Askew et al. suggests the claimed ortho ester. One skilled in the art would expect the compounds to have similar properties.

Elliott et al. disclose an ortho ester having the formula (I). See column 1, lines 8-33.

Elliott et al. also disclose an ortho ester which is an adjacent, i.e., structurally similar, to the ortho ester having the formula (I) (see Table I). The claimed ortho ester having formula (I) would have been obvious to the skilled artisan because the close structural similarity of the ortho ester of Elliott et al. suggest the claimed ortho ester. One skilled in the art would expect the compounds to have similar properties.

The preambles for claims 6-8, 13 and 14 were not accorded any patentable weight because they are directed merely to intended use. See MPEP 2111.02.

Response to Amendment

9. The declaration under 37 CFR 1.132 filed March 26, 2004 is insufficient to avoid a rejection of claims 1-4, 6-8, 13 and 14 based upon 35 USC 103(a) over Askew et al. (US 4,450,087) because: it does not do a sufficient comparison between the instant compounds and the closest prior art compounds of Askew et al. For instance, although a compound, which is substantially similar to ex. 70 of Askew, is presented for comparison, there is no data showing that an actual comparison was made. Further it is not understood why a substantially similar compound to ex. 70 is being used, in particular since R is CH₃ in the compound of ex. 70, and not H as is the comparative compound 020219HR of the declaration. Further, the Examiner is not clear which compound of the prior art 3xMPEG 350 represents. Also the declaration is not convincing of unexpected results, i.e., give an explanation or provide information, which explains what is expected, so that it is clear that the results obtained are indeed unexpected.

It would also be helpful to the Examiner if the Applicants would provide a chart showing the differences in the compound structure of the instant compounds versus those of Askew et al. and how those differences lead to unexpected results.

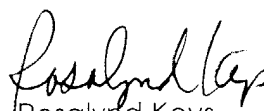
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalyn Keys whose telephone number is 571-272-

Art Unit: 1621

0639. The examiner can normally be reached on M, R and F 3:30-8:30 pm and T-W 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalyn Keys
Primary Examiner
Art Unit 1621

June 10, 2004